REMARKS

This paper responds to the non-final office action dated July 17, 2006.

Applicants respectfully traverse the rejections set forth in the office action in view of the remarks that follow and request withdrawal of those rejections.

A.   Interview Summary

On November 1, 2006, Mr. Cochran, the attorney of record in this application, telephoned Examiner Stork to discuss the present office action. During the interview, Mr. Cochran maintained that the "new" rejections set forth in the office action over the Bickmore patent in view of the Bickmore article were, in fact, duplicative of rejections that had previously been made and overcome via the appeal brief filed in this application. Mr. Cochran also pointed out that both the Bickmore patent and the Bickmore article were disclosed by the applicant almost 5 years ago, and therefore questioned the timing of the current rejections.
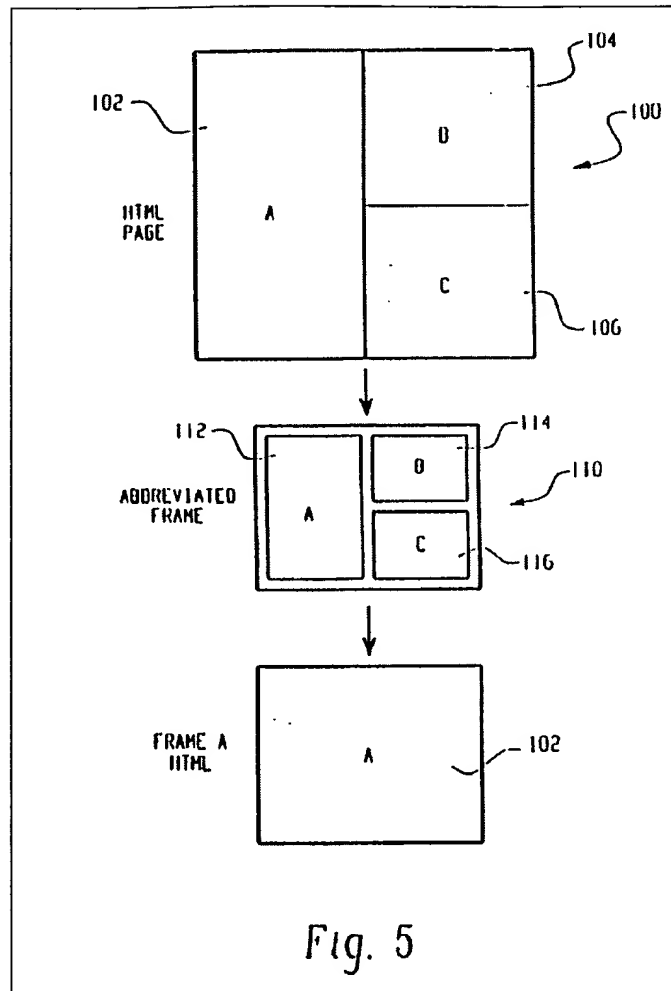
B.   Claims 22-50

Currently pending claims 22-44 describe a method and system for providing an information page, such as a web page, to a handheld, mobile viewing device, such as a PDA, cellular telephone, two-way pager, etc. (2:5-12)[1] Claims 45-50 describe a corresponding mobile device for receiving and processing such information pages. The methodology described in these claims is aimed at solving two problems: (1) how to provide graphically-laden information pages to handheld devices having limited memory capabilities; and (2) how to enable framed information pages to be viewed and accessed on such devices. (2:14-21)

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[1] (page:lines of specification)

The first problem is solved by generating an abbreviated version of the information page. (9:17 through 10:2) This abbreviated version includes a graphical representation of the information page. (Id.) The second problem is solved by including an image map along with the graphical representation of the information page, where the image map identifies the locations of the plurality of frames within the graphical representation of the information page. (10:9-15)

After the abbreviated version of the information page and the image map are provided to the handheld viewing device, the user of the device can select a particular frame of the page for more detailed viewing on the device. (10:12-15) This is accomplished by accessing the image map in response to selecting a portion of the graphical representation of the information page to determine the frame that responds to the selected portion and then retrieving a graphical representation of just the selected frame for further viewing on the handheld device. (Id.) This process is described graphically in Figure 5 of the application, which is set forth below.

Figure 5 shows an example framed HTML web page 100 as it would be rendered on a desktop computer system. The page 100 includes three separate frames 102, 104 and 106 where graphics, animations, text and other information can be independently displayed and viewed. (10:16-24)

Fig. 5

According to the method of claims 22-33, for example, the page 100 is first

converted into an abbreviated version of the page 100, the abbreviated version 110

being a graphical representation of the page 100, such as a bitmap file. (10:9-15) A

bitmap file cannot be accessed and manipulated, like the information page 100 can, and

therefore additional information must be generated to manipulate the abbreviated

version of the information page 100 – that information being the image map data. (Id.)

The image map provides a link between the original information page structure and the

graphical representation thereof. (Id.) Specifically, the image map defines an area of

the graphical representation that corresponds to each of the three separate frames. (Id.)

Thus, area 112 corresponds to the A frame, area 114 corresponds to the B frame, and area 116 corresponds to the C frame. The user of the handheld viewing device may then select a portion of the graphical representation, and the image map is then accessed to determine which frame, A, B or C, has been selected for further viewing. (11:1-10)

C. The Bickmore References Do Not Render the Claims Obvious

1. Law of Obviousness

In rejecting a claim under 35 USC § 103, the PTO follows the Supreme Court's guidance from Graham v. John Deere Co., 383 US. 1 (1966). In Graham, the Supreme Court set forth four factual inquiries as a background for determining obviousness: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations. Graham at 148. MPEP § 2141. The PTO Examiner's are to apply the Graham inquiries in meeting their burden to demonstrate a prima facie case of obviousness under 35 USC § 103.

MPEP § 2142 sets forth the legal concept of the prima facie case of obviousness under 35 USC § 103. According to the MPEP, "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP § 2142.

To establish the prima facie case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art references must teach or suggest all the claim limitations. MPEP § 2142. Importantly, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

     2.   The Obviousness Rejections of claims 22, 34 and 45 are Improper

Independent claims 22, 34 and 45 were rejected in the latest office action as being obvious over EP 0949571 (the Bickmore patent) in view of "Web Page Filtering and Re-Authoring for Mobile Users" (the Bickmore article). Applicants cited both of these references to the USPTO in an IDS dated November 27, 2001, almost five years ago. In prior office actions, the USPTO Examiner rejected then-pending claims 22-33 over the Bickmore patent in view of other references. All of these prior Bickmore rejections have now been withdrawn, however, at least partly due to the appeal brief filed on September 22, 2004. Applicants maintain that the deficiencies in the Bickmore patent that led to the withdrawal of those prior rejections are similarly deficient in the Bickmore article, which discusses the same exact topic as the Bickmore patent, and therefore all of these "new" rejections are improper and should be withdrawn.

As described above, independent claim 22 recites a method of providing an information page to a handheld viewing device. The method includes the following steps: (A) requesting an information page at the handheld viewing device; (B) retrieving the information page from a remote system; (C) if the information page includes a plurality of frames, then generating an abbreviated version of the information page, wherein the abbreviated version includes a graphical representation of the information

page and an image map that identifies the locations of the plurality of frames within the graphical representation of the information page; and (D) transmitting the abbreviated version of the information page to the handheld viewing device. Neither of steps (C) or (D) are disclosed or suggested by either of the Bickmore references and therefore the *prima facie* case of obviousness has not been met by the PTO.

The Bickmore patent teaches that a document is converted into sub-documents containing a portion of the original document:

> *"This invention separately provides systems and methods that automatically transform a document into a plurality of linked subdocuments, where each subdocument requires less display area."* (Bickmore at 3, II. 41-42)

> *"The automatic re-authoring system and method input a document to be re-authored and re-authoring parameters, such as display screen size, default font and the like. The automatic re-authoring system and method convert the document into a number of pages..."* (Bickmore, Abstract)

Figure 1 of the Bickmore patent shows the transformation of an original text document, having headings and associated text, to a re-authored sub-document in which the headings are retained, but the associated text is suppressed. When a user of the Bickmore system selects one of the text headings, the associated text is then retrieved and displayed.

Likewise, the Bickmore article describes the same exact "re-authoring" technique in which an original text document is re-authored into sub-documents, such as shown in Figure 4 at page 539 of the Bickmore article, and as described at pages 535-540. In

fact, Figures 4 and 5 of the Bickmore article are <u>identical</u> to Figures 1 and 2 of the Bickmore patent.

a.   The Bickmore References Do Not Disclose an Information Page Having Frames

Claims 22, 34 and 45 require an information page that includes a plurality of "frames." In this context the word "frame" is used as it would be to define a framed web page, although the claims are broader than web pages and may encompass other types of framed information pages. In the context of a web page, the term frame is defined as *"A rectangular section of the page displayed by a Web browser that is <u>a separate HTML document from the rest of the page</u>. Web pages can have multiple frames, each of which is <u>a separate document</u>."* (Microsoft Computer Dictionary, Third Edition, 1997, at page 207) Neither of the Bickmore references disclose <u>framed</u> information pages having <u>separate</u> HTML documents, but instead show a single HTML page structured as a table. (*See*, Figure 2 of the Bickmore patent and Figure 5 of the Bickmore article)

In prior office actions, the Examiner pointed to Figure 2 of the Bickmore patent for the alleged teaching of this limitation, but as demonstrated in the appeal brief, that figure does not show a "framed" information page – *i.e.*, a page that includes rectangular sub-pages that are separate documents – it shows a table. (See, Bickmore at 4:35-36, "Fig. 2 illustrates a layout table. . .") In fact, nowhere in the entire disclosure of the Bickmore patent is the word "frame" even used. A table is not a "framed" information page as that term is used in the present application, and as the term is commonly known to those skilled in the art as evidenced by the above-quoted

dictionary.

In the latest office action, the Examiner concedes that the Bickmore patent "*does not specifically mention if the information page includes a plurality of frames. . .*" (Office action at 3) But, the Examiner then contends that such a structure is shown in the Bickmore article by referring to page 538, paragraph 3, which is discussing Figure 5 – a nested table structure. Figure 5 of the Bickmore article is identical to Figure 2 from the Bickmore patent. They both show nested table structures, not framed web pages. Indeed, the portion of text relied upon by the Examiner doesn't even use the word "frame" at all, but instead refers to a process of deconstructing the table structure into a plurality of sub-pages. This proves that the original table structure of the Bickmore article is not a framed information page as set forth in the present claims.

b.   The Bickmore References Do Not Disclose an Abbreviated Version of the Information Page

Claim 22 recites the step of "generating an abbreviated version of the information page, wherein the abbreviated version includes a graphical representation of the information page and an image map that identifies the locations of the plurality of frames within the graphical representation..." Claims 34 and 45 include similar limitations. Neither of the Bickmore references disclose or suggest such an abbreviated version of the information page.

In the latest office action, the Examiner concedes that the Bickmore patent does not teach this step, stating: "*Bickmore does not specifically mention. . . generating an abbreviated version of the information page, and an image map. . .*" But, the Examiner

now contends that such structures are found in the Bickmore article, pointing to pages 538 and 539 of this article. These portions of the Bickmore article, however, do not support the Examiner's reasoning, and clearly do not show either a graphical representation of the information page or an image map that identifies the locations of the plurality of frames within the graphical representation. Instead, page 538 describes the aforementioned nested table structure, and page 539 describes a process of removing images from a web page. These two portions of the Bickmore article are discussing completely different subjects, however, with the first portion at page 538 describing the deconstructing of a nested table, and the second portion at page 539 describing a process for removing images from a web page and replacing the images with text links. There is no teaching in these portions of the Bickmore article that would lead the person of skill in the art to generate an abbreviated version of an information page including a graphical representation and an image map, where the image map <u>identifies the locations of the plurality of frames within the graphical representation</u>.

As previously stated, the claimed purpose of the image map is to "identify the locations of the plurality of frames within the graphical representation." The Bickmore article, like the Bickmore patent, doesn't even show frames, and therefore couldn't possibly teach such an image map. Moreover, although the phrase "image map" appears in the Bickmore article, it has nothing to do with identifying <u>the locations of frames</u> in a graphical representation of an information page, as required by the claims. Instead, the "image map" in the Bickmore article is describing a technique for removing images from a web page and replacing the images with a text list of hypertext links: "*If screen space is too limited or the client device cannot display images, Digestor will*

remove them from the document. However, images can be used as anchors for hypertext links via a client-side image map. . . Digestor incorporates a transform that extracts the hypertext links from such images and formats them into a text list of link.anchors." Thus, the "image map" in the Bickmore article is related to transforming inline images into hyperlinks, it is not related to identifying the locations of a plurality of frames in a web page.

For all of the reasons stated herein, applicants maintain that the present claims distinguish over the combination of the Bickmore patent with the Bickmore article, and therefore the application is in condition for allowance.

Respectfully submitted,

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